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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,564	07/01/2002	Kevin B Hatton	272/068	6594

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LYON & LYON LLP
633 WEST FIFTH STREET
SUITE 4700
LOS ANGELES, CA 90071

EXAMINER

MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 07/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/088,564	HATTON, KEVIN B	
	Examiner	Art Unit	
	Sanza L McClendon	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 provides for the use of the curable composition according to claim 1 as an adhesives, primers for adhesives, laminating and casting resins, moulding compositions, putties and sealing compounds, potting and insulation compounds, as coatings or stereolithographic type applications, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 6 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Objections

3. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in

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independent form. There is no oxetane compound in the composition of claim 4 as specified in claim 1.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Takami (6,166,101).

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Takami teaches ultraviolet radiation curable compositions, comprising an alicyclic epoxy resin (A), an oxetane compound (B), a compound having an oxetane ring and hydroxyl group (C), a compound having either at least two oxetane groups or one oxetane group and an epoxy group (D), a cationic polymerization initiator (E)—see abstract. This anticipates claim 1. In addition to the above the composition can comprise modifying resins, such as polyol resins or epoxidized butadiene resins, a lubricity-imparting agent, such as a fatty acid ester wax; wherein said fatty acid ester wax has at least 1/3 of the total number of hydroxyl groups esterified with said fatty acid—see column 13, lines 25-35 and 58-60. Said polyols can be selected from those listed in column 13, lines 38-45. This appears to anticipate the polyol and formula (III) of applicant's claim 2.

Said oxetane compound (B) can be represented by formula (1) in column 4, line 50, which appears to anticipate the formula of claim 2. Said epoxy resin (B) can be represented by formula (3) in column 3, line 5, which represents compounds such as those listed in column 3, lines 54-67, such as 3,4-epoxycyclohexylmethyl-3, 4-epoxycyclohexane carboxylate, wherein it appears applicant's formula in claim 2 is anticipated. Per example 1, Takami teaches curing a mixture of 3,4-epoxycyclohexylmethyl-3, 4-epoxycyclohexane carboxylate (A), a hydroxyl containing oxetane, a dioxetane compound, a cationic photoinitiator, and an a fatty acid ester wax with ultraviolet radiation to produce a coating composition for cans. This appears to anticipate claims 5-6.

With respect to claim 4, it is assumed by examiner that the composition as defined in claim 4 has an oxetane compound as specified in the parent claim 1. Therefore, it appears that the examples as taught by Takami anticipate the composition of claim 4 because said composition comprises an oxetane compound, a 3,4-epoxycyclohexylmethyl-3, 4-epoxycyclohexane carboxylate resin, a

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cationic photoinitiator, and a polyol (fatty acid ester wax comprising free hydroxyl groups).

6. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Takami et al (5,721,020).

Takami teaches ultraviolet radiation curable compositions, comprising a cationic-polymerizable compound (A), an oxetane compound comprising at least one oxetane group and one hydroxyl group (B), a cationic polymerization initiator (C), and a lubricity-imparting agent—see abstract. This anticipates claim 1. In addition to the above the composition can comprise modifying resins, such as polyol resins or epoxidized butadiene resins and polyols, such as adduct between a trihydric alcohol and ϵ -caprolactone. Said lubricity-imparting agent can be a fatty acid ester wax; wherein said fatty acid ester wax has at least 1/3 of the total number of hydroxyl groups esterified with said fatty acid—see column 13, lines 25-35 and 58-60.

Said cationic polymerizable compound is preferably an epoxy compound that can be represented by formula (1), column 3, line 25, which represents such compounds as 3,4-epoxycyclohexylmethyl-3, 4-epoxycyclohexane carboxylate. This anticipates the epoxy of claim 1 and the formula of claim 2. In addition 3,4-epoxycyclohexylmethyl-3, 4-epoxycyclohexane carboxylate anticipates the 7-oxabicyclo [4.10] hept-3-ylmethyl ester-7-oxabicyclo [4.1.0] heptane-3-carboxylic acid in the Markush group of claims 3-4. Takami et al teaches component (B) can be, as opposed to the above definition, a compound having at least two oxetane groups or an oxetane group and an epoxy groups (B-2). Said oxetane compound (B-2) can be represented by formula (4) in column 5, line 5, which appears to anticipate the formula of claim 2 and represents compounds such as 3,3-[1,4- phenylene bis(methyleneoxymethylene0)-bis (3-ethyloxetane) in claim 3. Said oxetane compound (B) can be represented by either formula (4) or, more specifically, formula (4-1), which, also, appears to anticipate the

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formula of claim 2 and represents such compounds as 3-methyl-3-oxethanemethanol or 3-ethyl-3-oxethanemethanol in claim 3.

Per example 5, Takami et al teaches radiation curing a composition comprising 3,4-epoxycyclohexylmethyl-3, 4-epoxycyclohexane carboxylate, a dioxetane compound represented by formula 16 (column 14, line 60), a cationic curing agent, and a TONE® 0305, which is a polyol of ϵ -caprolactone. This appears to anticipate claim 1 and 5. Per examples 9-10, and 12, Takami et al teaches curing a composition comprising 3,4-epoxycyclohexylmethyl-3, 4-epoxycyclohexane carboxylate, 3-ethyl-3-hydroxylmethyloxetane, a cationic photoinitiator, and TONE® 0305, which is a triol of ϵ -caprolactone. This appears to anticipate claim 3 and 5, wherein said compositions are suitable for coating on aluminum cans, which appears to anticipate claim 6.

With respect to claim 4, it is assumed by examiner that the composition as defined in claim 4 has an oxetane compound as specified in the parent claim 1. Therefore, it appears that the examples as taught by Takami et al anticipate the composition of claim 4 because examples 9-10 and 12 comprises an oxetane compound, a 3,4-epoxycyclohexylmethyl-3, 4-epoxycyclohexane carboxylate resin, a cationic photoinitiator, and a polyol.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (703) 305-0505. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0657.

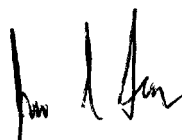
Sanza L McClendon

Examiner

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SMc

July 22, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700